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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,731	04/16/2004	K. William Mopper	200955-9009-01	1367

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MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

EXAMINER	
WILSON, JOHN J	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/826,731	MOPPER, K. WILLIAM	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 16-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 16-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Supplemental Action Restarting Period

This is a supplemental action to correct an error in the Office Action mailed September 13, 2006. The cover letter was titled "Office Action Summary for Applications Under Accelerated Examination". Because the present application was not filed under Accelerated Examination, a new action with the correct cover letter is being issued.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemetz et al (6149430) in view of Jefferies (6093084) and Suh et al (6386865). Nemetz shows a dental bur used with a low speed hand piece for finishing work, column 6, lines 5-12. Nemetz does not show the specific use of the device with finishing work that includes a resin based material. Jefferies shows doing finishing work with a resin based material, column 10, line 44. It would be obvious to one of ordinary skill in the art to modify Nemetz to include the use of a resin based material as shown by Jefferies in order to make use of well known materials for tooth repair. Nemetz does not state the torque used. The terminology "high torque" is a relative term that is broad and subject

to interpretation. It is held that the inherent torque of Nemetz is within the range of "high torque". The above combination does not show using a fluted bur or creating secondary to tertiary anatomy. Suh teaches using a fluted bur to obtain occlusal anatomy, column 18, lines 57-59. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a fluted bur for occlusal anatomy as shown by Suh in order to best shape the restoration. To create secondary and tertiary anatomy when shaping the tooth is well known in the art, and as such, would have been obvious to the skilled artisan. Creating a smooth enamel-like finish is held to be a broad limitation because the term smooth is relative and open to interpretation, and as such, this step would be obvious in the use of the method above. The range of flutes used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art. As to claim 2-4, Nemetz teaches low speed as being less that 50,000 rpm, column 6, line 10, while Jefferies teaches finishing work at speeds of 50-10,000 rpm, column 17, lines 25-30. The specific range of low speed used is an obvious matter of choice in degree of a known parameter to one of ordinary skill in the art. As to claim 4, the ability to maintain continuous pressure and constant speed depends on the degree of pressure applied by the user and is held to be an obvious matter of choice in the degree of pressure used. As to claims 7, 8, 22 and 23, Jefferies teaches that burs can be formed from steel or carbide, column 16, lines 40-47. As to claims 16-21 using more than on bur with increasing flutes to provide for increased level of fine finishing is well known in the art, and as such, using two burs is an obvious matter of choice to one of ordinary skill in the art.

Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemetz et al (6149430) in view of Jefferies (6093084) and Suh et al (6386865) as applied to claim 1 above, and further in view of Gerteisen (3872594). The above combination does not show using straight flutes. Gerteisen shows straight flutes in the drawings. It would be obvious to one of ordinary skill in the art to modify the above combination to include using straight flutes as shown by Gerteisen in order to make use of know flute types to obtain the desired results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 16-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No.

6,783,366. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not include using the specific range of flutes and RPM together would have been obvious to one of ordinary skill in the art in not using steps. To use more than one bur is well known, and as such, would have been obvious to one of ordinary skill in the art to obtain the desired finish.

Drawings

The drawings submitted April 16, 2004 have been found to be acceptable by the examiner.

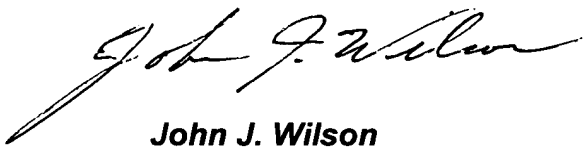
Conclusion

The additional cited prior art was cited in the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
October 6, 2006